

Remarks

I. Status of claims

Claims 1-20 are pending.

II. Claim rejections under 35 U.S.C. § 103

A. Claims 1-12 and 14-20

Claims 1-12 and 14-20 are rejected under 35 U.S.C. § 103(a) over Tokunaga (US 2004/0160430) in view of Bryborn (US 2003/0107558).¹

1. Independent claim 1

Independent claim 1 has been amended and now recites:

1. (currently amended) A method of producing an electronic document with a digital pen comprising a tip, a processor, and memory, comprising :

the processor acquiring data relating to the locations of the tip over a surface based on a position-identifying pattern associated with the surface;

the processor recognizing a page division marker in the acquired data;

based on recognition of the page division marker, storing the acquired data in the memory as a separate page of the electronic document;

after the recognizing and the storing, the processor obtaining data relating to the location of the tip of the pen over a surface having the position-identifying pattern and storing the obtained data in the memory as a separate page of the electronic document; and

¹ The Examiner has indicated that dependent claims 14-18 are rejected under 35 U.S.C. § 103(a) over Tokunaga in view of Bryborn. However, the Examiner has relied exclusively on Tokunaga in the rejection of each of claims 14-19 (see page 12-13 of the final Office action). For this reason, the undersigned has assumed that the rejection of claims 14-18 is under 35 U.S.C. § 103(a) over Tokunaga.

transmitting the data stored in the memory to a computer.

The rejection of independent claim 1 under 35 U.S.C. § 103(a) over Tokunaga in view of Bryborn should be withdrawn because Tokunaga in view of Bryborn does not disclose or suggest all the elements of the claim.

For example, Tokunaga in view of Bryborn does not disclose or suggest the “obtaining” element (i.e., “after the recognizing and the storing, the processor obtaining data relating to the location of the tip of the pen over a surface having the position-identifying pattern and storing the obtained data in the memory as a separate page of the electronic document”) now recited in claim 1.

Regarding Tokunaga, the Examiner has taken acknowledged that Tokunaga fails to explicitly teach the “creating” element in the prior version of claim 1 (i.e., “creating a page division marker in pen-acquired data by making a gesture with the pen upon the first page of physical media indicative of termination of use of the first page of a document”). Since Tokunaga does not disclose recognizing a page division marker in the acquired data, Tokunaga cannot possibly disclose or suggest “after the recognizing and the storing, the processor obtaining data relating to the location of the tip of the pen over a surface having the position-identifying pattern and storing the obtained data in the memory as a separate page of the electronic document,” as now recited in claim 1.

In Bryborn, the pattern on each physical sheet is unique, and the pattern at each location on a given physical sheet is unique (see, e.g., the references listed in ¶ 64, copies of which are provided with the Information Disclosure Statement filed herewith). Therefore, Bryborn does not disclose or suggest “after the recognizing and the storing, the processor obtaining data relating to the location of the tip of the pen over a surface having the position-identifying pattern and storing the obtained data in the memory as a separate page of the electronic document,” where “the position-identifying pattern” was used as a basis for acquiring data that that previously was stored as a separate page. If a user should write in the same area of a physical sheet during the same session, Bryborn's system would locate those strokes on the same page of the electronic document because the allocation of the strokes on the physical sheet are mapped to pages of the electronic document based on the unique page address (see, e.g., ¶74) and the

coordinates on the page (see, e.g., ¶76). In addition, if the page break mark is entered on the physical sheet, the strokes that are made by Bryborn's system after the page break mark would be allocated to a separate electronic document page from the strokes that were made on the same page before the page break mark; however, these subsequent strokes would not be made over a surface having the same position-identifying pattern as the previous strokes because the pattern at each location on a given physical sheet is unique (see, e.g., the references listed in ¶ 64).

For the reasons explained above, the rejection of independent claim 1 under 35 U.S.C. § 103(a) over Tokunaga in view of Bryborn should be withdrawn.

2. Dependent claims 2-12

Each of claims 2-12 depends from independent claim 1 and therefore is patentable over Tokunaga in view of Bryborn for at least the same reasons explained above in connection with independent claim 1.

3. Independent claim 19

Independent claim 19 recites:

19. (previously presented) Software, optionally encoded upon a machine-readable storage medium, which when executed upon a processor causes the processor to:

(i) receive a first signal, indicative of the position of a pen upon a first piece of physical media having printed thereupon a position location pattern that is common with a second piece of physical media;

(ii) receive a second signal indicative of strokes, and the location of said strokes, of the pen upon the second piece of physical media;

(iii) use the first and second signals to produce a digital document; and

(iv) create an end of electronic document division marker in pen-acquired data by making a gesture with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal.

The rejection of independent claim 19 under 35 U.S.C. § 103(a) over Tokunaga in view of Bryborn should be withdrawn because Tokunaga in view of Bryborn does not disclose or suggest all the elements of the claim.

For example, Tokunaga in view of Bryborn does not disclose or suggest the “create” element of claim 19 (i.e., “create an end of electronic document division marker in pen-acquired data by making a gesture with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal”).

In the rationale given by the Examiner in support of the rejection of claim 19, the Examiner has acknowledged that Tokunaga fails to teach the “create” element of claim 19 (see page 11 of the final Office action). In an effort to make up for this lack of disclosure, the Examiner has taken the position that (bottom of page 11 of the final Office action):

In a similar field of endeavor, Bryborn discloses electronic pen and method for recording of handwritten information. In particular, Bryborn teaches (iv) create an end of electronic document division marker (page break second type pen stroke) in pen acquired data by making a gesture (second type pen stroke) with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal (paragraph 108 and 107).

Contrary to the Examiner's position, however, Bryborn does not disclose or suggest a process operable to “create an end of electronic document division marker in pen-acquired data by making a gesture with the pen upon the first piece of physical media, the gesture coding for an end of electronic document signal,” as recited in claim 19. In particular, the “page break” format parameter mentioned in Bryborn does not constitute an “end of document division marker;” instead, the page break marks a division between two pages within the same document. Indeed, in accordance with Bryborn's express teachings, the end of the electronic document is determined from the end of the current working session of the pen (see, e.g., ¶¶ 27, 66, 74, 77).

For the reasons explained above, the rejection of independent claim 19 under 35 U.S.C. § 103(a) over Tokunaga should be withdrawn.

4. Dependent claim 20

Claim 20 depends from independent claim 19 and therefore is patentable over Tokunaga in view of Bryborn for at least the same reasons explained above in connection with independent claim 19.

B. Claims 13-18²

1. Independent claim 13

Independent claim 13 is rejected under 35 U.S.C. § 103(a) over Tokunaga (US 2004/0160430).

Independent claim 13 recites:

13. (original) A digital pen adapted for use with a page of position-determining pattern, the pen having:

a memory;

a pattern position capturer adapted to capture data relating to the position of the pen in relation to a said pattern and to store pen position data in a memory;

a clock adapted to produce time signals; and wherein

the pen has a processor having software adapted to associate time signals with the pen position data and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page having the same pattern, and to either:

- (i) create a page end marker in the pen-captured data; or
- (ii) store pen-acquired data from different physical pages, each having the same pattern, in different electronic files in the memory of the pen.

The rejection of independent claim 13 under 35 U.S.C. § 103(a) over Tokunaga should be withdrawn because Tokunaga does not disclose or suggest all the elements of the claim.

² See footnote 1.

For example, Tokunaga does not disclose or suggest “a processor having software adapted to associate time signals with the pen position data and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page,” as recited in claim 13.

In support of the rejection of claim 13, the Examiner has taken the position that Tokunaga discloses “a processor having software adapted to associate time signals with the pen position data and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page” in ¶¶ 6, 8, and 57 (page 4 of the final Office action; emphasis added):

... Paragraph 6 and 57 teaches at some point the pen stops recording data in any of the absolute coordinate space signifying a page among a plurality of pages and the data is transmitted via the network to the computer for display. One of ordinary skill in the art would reasonably interpret one of the plurality of data transmissions would eventually have the last data to be recorded signifying end of page. In addition, paragraph 8 teaches plural sheet of paper having an identical pattern which has to be discerned which paper the data entry has been made. As such, one of ordinary skill in the art would reasonably interpret the teachings of paragraphs 6, 8, and 57 as teaching having the same pattern (dot pattern per plural sheet of paper) and having software (via camera 203, memory 207 and data transmission over network 119, and/or computer 103) adapted to associate time signals with the pen position data (paragraph 6) and to evaluate pen position with time to determine when a user has finished marking a first physical page and begins marking a second physical page having the same pattern (paragraph 6 and 8) ...

The Examiner's position is unpersuasive, however, because it is premised on a misconstruction of the language of claim 19. In particular, the Examiner has cited instances in which an electronic pen system determines which page the user is writing on as evidence that Tokunaga discloses determining “when a user has finished marking a first physical page.” To the contrary, however, the determination of the pages on which a user is writing (either by determining the unique location of the pages in a global coordinate system (¶ 7) or by determining which uniquely positioned checkboxes are checked (¶ 9)) does not reveal anything about whether or not a user has finished with any particular page. In addition, the Examiner's

observation that "at some point the pen stops recording data" and that there eventually will be a data transmission that has the last data to be recorded does not establish that Tokunaga discloses an electronic pen system that determines when a user has finished marking a first page. Indeed, Tokunaga does not disclose or suggest anything from which an electronic pen system could infer "when a user has finished marking a first physical page."

For the reasons explained above, the rejection of independent claim 13 under 35 U.S.C. § 103(a) over Tokunaga should be withdrawn.

2. Dependent claims 14-18

Each of claims 14-18 depends from independent claim 1 and therefore is patentable over Tokunaga for at least the same reasons explained above in connection with independent claim 13.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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